85-1781

No.

Supreme Court, U.S.
FILED
MAR 1986
JOSEPH F. SPANIOL, JR.
CLERK

SUPREME COURT OF THE UNITED STATES

October Term 1986

IN THE MATTER OF THE PATENT APPLICATION OF

RICHARD FOTLAND and JEFFREY CARRISH,

PETITIONERS

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION

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QUESTIONS PRESENTED FOR REVIEW

This petition presents the following questions:

1. May the Federal Circuit construe a federal statute as including a requirement which is absent from the express wording of the statute?

The foregoing question presents the following subsidiary question:

1a. Is it appropriate for the Federal Circuit to amend a federal statute to include provisions which Congress has seen fit to omit?

LIST OF PARTIES

1. Richard Fotland and Jeffrey Carrish, Petitioners.
2. Commissioner of Patents and Trademarks, Respondent.

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IN THE

SUPREME COURT OF THE UNITED STATES

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioner respectfully prays that a writ of certiorari issue to review the judgement of the United States Court of Appeals for the Federal Circuit in its case No. 85-1546. The judgement was entered on December 12, 1985.

OPINIONS BELOW

The opinion of the Court of Appeals has been reported at _____F.2d_____ (CAFC 1985) and is reprinted in the appendix to this petition commencing at page 1a.

JURISDICTION

The judgement for which review by this Court is sought was entered on December 12, 1985. This Court has jurisdiction by virtue of 28 U.S.C., Section 1254(1).

THE CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED

U.S. Constitution, Amendment V

"No person shall ... be deprived, of life, liberty or property, without due process of law ..."

35 U.S.C., Section 251

Reissue of defective patents

"Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid ... the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent ...

.

.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."

STATEMENT OF THE CASE

This case originated as an application for reissue in the U.S. Patent Office under 35 U.S.C. 251.

(a) The Prosecution Before the Patent Office.

In the first Office Action the Examiner rejected Claims 1-29 as lacking a statutory basis for a reissue "because the patent is not deemed wholly or partly inoperative or invalid." The Examiner noted that the reissue declaration "is defective" and directed Applicants' attention to "a detailed discussion and description of a valid declaration."

In response Applicants amended the reissue application and presented additional claims as an alternative statement of the invention. This amendment was accompanied by a Declaration of August 17, 1981 to broaden the reissue application.

In a Notice of September 22, 1981 the Examiner stated that the amendment was informal and Applicant was given one month to correct the informality. The Amendment to Claims 1 and 16 was held to be nonresponsive and additional Claims 30 through 33 were said to fail to comply with 37 CFR 1.173 and were not entered. Section 1.173 merely states that additions made by the reissue must be underlined. Applicant complied with this request by an Amendment filed October 2, 1981.

The Response by the Examiner was a final Office Action of November 17, 1981. The Examiner rejected the Claims solely because the reissue declaration did not comply with 37 CFR 1.175 by failing to state when and the manner in which the reissued Applicant became aware of the error. The Examiner also stated "if Applicants can submit a proper reissue oath, then the claims presented would be deemed allowable" and called attention to 37 CFR 1.178 on surrender of the issued patent.

In response, Applicants presented the required reissue oath along with new claims 34 through 36. In an Advisory Action mailed March 18, 1982 the Examiner rejected the new reissue declaration oath as insufficient because the "review of patented claims in the spring of 1981 was after this reissue application was filed."

A supplementary Amendment was filed on April 16, 1982 which also was not entered pursuant to an Advisory Action of April 30, 1982. This was followed by Applicant's Notice of Appeal of May 19, 1982. The application was subsequently held to have been abandoned, but was later revived.

(b) The Decision of the Patent Office Board of Appeals

The Board sustained the final rejection by the Examiner under 35 USC 251 that the application involved an improper broadening reissue.

The Board concluded: "no real application" for reissue was filed within the statutory grace period provided in 35 USC 251. The Board said that a reissue application under 37 CFR 1.176(a) (4) is "nothing more than a request for an advisory opinion from the Patent and Trademark Office", citing *In re Dien*, 680 F.2d 151, (CCPA 1982) and *In re Bose*, 687 F.2d 432, (CCPA 1982). The "attempted conversion" of the application "to a regular reissue application" was said to be outside of the statutory period.

As to *In re Doll*, 419 F.2d 925 (CCPA 1970) relied on by Appellants, "did not have a timely filed broadened reissue application which was further broadened outside of the statutory period as in Doll.' The Board stated: "Appellants took no action within the two year period which would entitle them to a real examination of their application" and "did nothing more during the two year period than request an advisory opinion from the Patent and Trademark Office".

(c) The Decision of the Federal Circuit

The Federal Circuit ignored the express words of 35 USC 251 that only a reissue patent needs to be applied for within two years from the grant of the original patent and read into the statute language that is not there, namely that the reissue patent must be applied for "with claims of enlarged scope."

REASONS FOR GRANTING OF THE WRIT

The Court should issue the writ of certiorari in this case because the Federal Circuit's action is grounded upon a total disregard of the clear wording of 35 USC 251.

I. A REISSUE APPLICATION FILED WITHIN TWO YEARS OF PATENT ISSUANCE MAY BE BROADENED MORE THAN TWO YEARS AFTER ISSUANCE.

The Federal Circuit (as well as the Board and the Examiner) state the issue in terms of a "no defect" reissue and distinguish it from some other reissue - but there is no statutory or even rule classification as such. The statute and the rule recognize only "reissues". The CCPA has ruled that a reissue application can be broadened more than two years after issuance without violating 35 USC 251. *In re Doll*, 419 F.2d 925 (CCPA 1970). *Doll* specifically addresses the question of whether a timely reissue application may be broadened more than two years later.

In concluding that such broadening is permissible, the CCPA construed the language of Sec. 251. The CCPA stated that "although the language of 35 USC 251 appears... free of ambiguity" it looked into the legislative history to see if there were any intent contrary to "the apparent meaning of the language."

The CCPA concluded: "It appears clear that the term 'applied for' refers to the *filing of an application*" (emphasis added). The Federal Circuit, by contrast, would have Sec. 251 amended to read (with the amendatory language quoted and italicised):

> No reissued patent shall be granted enlarging the scope of the claims of the original patent unless *"the claims of enlarged scope are"* applied for within two years from the grant of the original patent.

As stated by the CCPA, "applied for" refers to the *application* and *not the claims*.

The decision by the CCPA in *In re Bauman*, 683 F.2d 405 (CCPA 1982) is similar. The fact that a reissue application was invalid did not bar it from providing a filing date for a continued application.

As to the rights of the public, the CCPA said in *Doll* that the public is safeguarded by virtue of intervening rights provisions, which also apply here.

On the concern that a no-defect reissue could be filed just prior to the two year period and allow a patentee to monitor developments in the law, that is true of any reissue application.

As in *Bauman*, the practical effect of the Federal Circuit's position is that applicants are required to proliferate and file additional *applications* to resolve all doubts.

II. ONCE A REISSUE APPLICATION IS TIMELY FILED, AN APPLICANT CAN AMEND CLAIMS AND TAKE WHATEVER ACTION IS NEEDED TO PERFECT THE APPLICATION.

The reliance on *In re Dien*, 680 F.2d 151, (CCPA 1982), is inappropriate. In this case, the CCPA dismissed for lack of jurisdiction.

In *Dien*, the appellant did not seek to "amend its patent or to comply with any provisions of Rule 175 other than paragraph (a) (4)..."

The Federal Circuit has incorrectly construed this decision as stating that a section (a) (4) reissue *never* invokes a "true" reissue. Rather, in the cited case a "true" reissue had not been invoked *at the time* the cases were heard. In the instant case the original reissue application has in fact matured into a broadening issue. A "true" reissue has existed from the time the section (a) (4) application was filed, for the claims were subject to broadening at *any* time after the filing. *In re Doll, supra.*

An analogy may be drawn to 35 USC 102 (e) where a patent is deemed effective as a reference as of the time it was filed. It is a policy of the Statute to avoid adversely affecting the rights of the public and a patentee simply because of delays attendant with Patent Office prosecution.

Similarly, in the instant case, the reissue application was timely filed under 35 USC 251, with merely delayed introduction of broadening claims. However, once the action of filing is timely taken, the applicant is entitled to perfect his rights by broadening claims, if that is indicated to be appropriate.

Applicants here gave notice of their intention to seek possible reissue coverage when they filed their original reissue application.

III. THE RULING THAT A REISSUE APPLICATION UNDER 37 CFR 1.175(a) (4) IS "NOTHING MORE THAN A REQUEST FOR AN ADVISORY OPINION" IS ERRONEOUS AND CONTRARY TO 35 USC 251.

37 CFR 1.175(a) (4) at the time of filing the reissue application specifically provided that "...Applicant may be permitted to amend the patent and be granted a reissue patent."

Under section (a) (4), where the Examiner deems that patent wholly or partially inoperative, an applicant can seek to overcome the inoperativeness. This may result in a broadening of the claims. For example, an original application may have disclosed elements *A* and *B* and claimed only the combination of *A* and *B* without considering the novel aspects of either *A* and *B* alone. In a reissue prosecution under Section (a) (4), a reference could be presented which discloses the combination of *A* and *B*, but does not disclose novel aspects of *B* alone, or *A* alone. A proper response, then, could be to claim either *B* or *A* broader and alone, thus broadening the claims.

When the Federal Circuit states that the invocation of Section (a)(4) is "seeking and obtaining the benefit of the Examiner's review of new information", it ignores the fact that Section (a)(4), *on its face*, provides for the possibility of amendment. In addition, Section (a)(4) is specifically designated as a reissue provision. It is one of six specifically enumerated reissue procedures available to a patentee. There is nothing in the Rules to indicate that the fourth provision of reissue provisions is not really a reissue provision.

Under Section (a)(4), Applicants offered to surrender their patent and thus anticipated the reissuance of the original patent. This offer was made on June 27, 1980, within two years of issuance of the patent on May 15, 1979. This is specifically permitted by the clear language of Section (a)(4), upon which Applicants are entitled to rely.

IV. THE PATENT OFFICE INITIALLY AND PROPERLY ACQUIESCED IN THE BROADENING OF THE REISSUE APPLICATION.

In the initial action by the Examiner, the claims were rejected solely as lacking a statutory basis for reissue. Applicant's attention was directed to the requirements for a valid declaration, constituting a recognition by the Examiner that the defective declaration could be cured. In response, Applicants amended the application for reissue more than two years after patent issuance and presented additional claims to provide an alternative statement of the invention. This amendment was accompanied by an appropriate declaration. The initial response by the Examiner to the broadening amendment and declaration, which were more than two years after patent issuance, were merely to object to informalities and give Applicants one month to correct the informalities.

After Applicants attempted to cure the informalities, the Examiner responded in a final Office Action by rejecting the claims solely because the reissue declaration failed to state when and the manner in which the error occurred, *again more than two years after patent issuance.*

The Examiner noted, "If Applicants can submit a proper reissue oath, the claims would be deemed allowable."

The entire course of action to this point by the Patent Office constituted a recognition that a reissue application had been timely filed and that Applicants could correct any deficiencies in the application in order to perfect the reissue application and receive benefit from it.

The application was originally filed as a request for a reissue within two years of patent issuance. It is established that a reissue application can be broadened more than two years after issuance if the original application was filed within the two year period. *In re Doll*, *supra*. In addition, as long as the original application was timely, the fact that it might prove to be invalid or defective would not bar it from providing a timely filing date for a continuation. *In re Bauman*, *supra*.

Admittedly if a reissue application is not perfected the result can be nothing more than a request for an advisory opinion. That is not the case here where subsequent action was taken to perfect the reissue application. This could have been in response to an action of the Examiner, but it is immaterial that it was *sua sponte* by Applicants.

CONCLUSION

Appellants "applied for" a Reissue Application within two years of the patent date of May 15, 1979. That is all the Statute requires. The rule in effect at the time did not distinguish between broadened and so-called "no-defect" reissues.

All Applicants have done is to timely perfect their original reissue application.

Respectfully submitted,

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Court of Appeals, Federal Circuit

In re Fotland, et al.

No. 85-1546

Decided December 12, 1985

PATENTS

1. Pleading and practice in Patent Office — Rules effect (§54.9)

Reissue — In general (§58.1)

"No defect" reissue application filed under 37 CFR 1.175(a)(4) within two years after patent grant does not comply with 35 USC 251, in view of applicant's failure to seek to enlarge scope of claims within two-year period.

Appeal from U.S. Patent and Trademark Office, Board of Appeals.

Application for patent of Richard A Fotland and Jeffrey J. Carrish, Reissue, Serial No. 177,297. From affirmance of rejection of all claims, applicants appeal. Affirmed.

George E. Kersey, Framingham, Mass. (Barry D. Josephs and Gary S. Winer, on the brief) for applicants.

Fred E. McKelvey, Deputy Solicitor, U.S. Patent and Trademark Office (Joseph F. Nakamura, Solicitor, and Michael L. Gellner, Assistant Solicitor, on the brief) for Patent and Trademark Office.

Before Markey, Chief Judge, Baldwin and Newman, Circuit Judges.

Newman, Circuit Judge.

We affirm the decision of the United States Patent and Trademark Office Board of Appeals (Board), which in turn affirmed the examiner's rejection of all of the claims of Fotland and Carrish's reissue application Serial No. 177,297 (the '297 application).

We hold that a "no defect" reissue application that was filed under 37 C.F.R. §1.175(a)(4) within two years after the grant of the patent did not provide a basis for compliance with 35 U.S.C. § 251, fourth paragraph, when the patentee first sought to enlarge the scope of the claims more than two years after the patent grant.

Background

Fotland and Carrish's U.S. Patent No. 4,155,093 (the '093 patent) entitled "Method and Apparatus for Generating Charged Particles" was granted on May 15, 1979. A "no defect" reissue application citing new references was filed pursuant to 37 C.F.R. §1.175(a)(4) on August 11, 1980, within two years of patent grant. This regulation[1] enabled patentees to obtain review of their patent claims in light of information not previously considered by the examiner, without amending the claims or the specification and without stating that the patent was believed by the patentee to be wholly or partly inoperative or invalid:

> §1.175 Reissue oath or declaration.
>
> (a) Applicants for reissue, in addition to complying with the requirements of the first sentence of § 1.65, must also file with their applications a statement under oath or declaration as follows:

[1] Effective March 1, 1977, 37 C.F.R. § 1.175 was amended to add subparagraph (a)(4). 42 Fed. Reg. 5588, 5594-95 (Jan. 28, 1977). The "no defect" reissue practice was repealed effective July 1, 1982. 47 Fed Reg. 21746, 21748-49, 21752 (May 19, 1982).

* * *

> (4) When the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid, particularly specifying such prior art or other information and requesting that if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent.

Appellants' declaration, submitted with the petition for reissue, averred:

> They do not believe that the foregoing references would cause the Examiner to deem the original patent fully or partly invalid on the basis of 35 U.S.C. § 103. They request, however, if the Examiner so rule, that the applicants be permitted to amend the patent and be granted a reissue patent.

On April 17, 1981, the examiner rejected all the submitted claims, which were all of the patent claims as originally granted, "as lacking statutory basis for a reissue because the patent is not deemed wholly or partly inoperative or invalid". The examiner also stated that the new references had "been carefully considered", and that "the claims define thereover". That is, the examiner concluded that there was no defect in the patent due to the newly cited references. Such action normally ends the proceedings, applicants' purpose of obtaining review of the claims in light of the new references having been successfully accomplished.

Applicants filed a response on August 17, 1981, amending several claims of the patent and adding four new claims. A "supplemental reissue declaration" was filed, and applicants stated that "[t]he effect of this declaration is to convert the present reissue application to one under 37 C.F.R. 1.175 subsection (a)(3)".[2] In the supplemental declaration Fotland and Carrish

[2] 37 C.F.R. § 1.175(a)(3) provides:

> When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly specifying the excess or insufficiency in the claims. [The phrase quoted is from 35 U.S.C. § 251, first paragraph.]

averred "that they verily believe the original patent to be wholly or partly inoperative by reason of the claiming less than they had a right to claim in this matter". Applicants declared that the independent claims contained certain "unduly narrow limitations" and that the claims of the '093 patent did not "explicity cover the preferred structural feature". Applicants also stated that such errors arose "because they were overlooked during the original prosecution of the case".

The examiner refused to reissue the '093 patent and the Board affirmed, holding that the claims could not be broadened by request first made more than two years after patent grant, even though a 37 C.F.R. § 1.175(a)(4) "no defect" reissue application was on file within the two year limit set in 35 U.S.C. § 251. The Board stated that the "no defect" reissue application was merely a request for an advisory opinion, citing *In re Dien*, 680 F.2d 151, 214 USPQ 10 (CCPA 1982) and *In re Bose*, 687 F.2d 432, 215 USPQ 1 (CCPA 1982). Because the applicants had failed to file a "real application for reissue within the statutory grace period provided in 35 U.S.C. § 251", the attempted conversion of the application was held untimely.

Analysis

The purpose of the law that a broadening reissue must be applied for within two years after patent grant is to set a limited time after which the public may rely on the scope of the claims of an issue patent. "[N]o one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent...." *Wollensak v. Reiher*, 115 U.S. 96, 100 (1885); *Webster Electric Co. v. Splitdorf Electric Co.*, 264 U.S. 463, 467-8(1924).

Prior to the 1952 Patent Act there was no fixed time limit for the filing of a broadening reissue and courts generally applied the principles of laches, frequently adopting a two-year limitation. It was codified in the fourth paragraph of 35 U.S.C. § 251, that:

> No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

P.J. Federico explained in his Commentary on the new Patent Act, 35 U.S.C.A. 1, 44 (West 1954):

> The new statute enacts a fixed period of two years from the grant of the original patent, within which to apply for a reissue "enlarging the scope of the claims of the original patent." Such a reissue cannot be obtained on an application filed more than two years after the date of the original patent, and presumably is timely if applied for within two years as far as the reissue requirements are concerned.

Appellants argue that they had a reissue application file within the two year period, and that their subsequent request for broadened claims is authorized by *In re Doll*, 419 F.2d 925, 164 USPQ 218 (CCPA 1970). In *Doll* the Court of Customs and Patent Appeals held that when a broadening reissue application was on file within the two year period, the claims could be further broadened after the two year period. Appellants argue that this also applies to "no defect" reissue applications that did not seek to enlarge the claims during the two year period. We must reject this position as contrary to precedent, contrary to regulation, and contrary to the plain language of §251.

No reissue patent can be granted on a §1.175(a)(4) reissue application. The application must first be removed from its "no defect" status by "the happening of future events in accordance with 35 U.S.C. § 251". *In re Dien*, 680 F.2d at 155, 214 USPQ at 14. The court in *Dien* observed that the appellants "[have] not *really* asked for a reissue — thus far — and [are] not going to get a reissue as matters now stand regardless of what we do on this appeal". *Id.* (emphasis in original). As stated in *In re Clark*, 522 F.2d 623, 625, 187 USPQ 209, 211 (CCPA 1975), determination of the sufficiency of grounds for reissue as set forth in the submitted oath is the "first order of business in examining an application for reissue."

Appellants' reissue application filed under §1.175(a)(4) did not assert broadened claims or allege a defect in their patent. In seeking and obtaining the benefit of the examiner's review of their new information, as enabled by §1.175(a)(4), appellants were not required to comply with other provisions of § 1.175, and did not do so. Not until appellants filed their supplemental declaration under § 1.175(a)(3) did they seek "a true reissue of [their] patent". *In re Dien*, 680 F.2d at 154, 214 USPQ at 14.

[1] Appellants argue that their offer of surrender of the '093 patent on June 27, 1980 "anticipated the reissuance", and thus met the requirements for a "true reissue" application within the two year limit. However, the requisite declaration and broadened claims were not filed until August 17, 1981, more than two years after the grant of the '093 patent. Congress limited to two years the time during which a patentee may apply for enlargement of patent claims. 35 U.S.C. § 251 supports no other than this plain meaning.

AFFIRMED